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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,868	07/02/2002	Jacob Wohlstadter	100390-06290	1273
22852 7590 03/08/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SINES, BRIAN J	
			ART UNIT 1743	PAPER NUMBER
			MAIL DATE 03/08/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/031,868	<b>Applicant(s)</b> WOHLSTADTER ET AL.	
	<b>Examiner</b> Brian J. Sines	<b>Art Unit</b> 1743	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 26 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

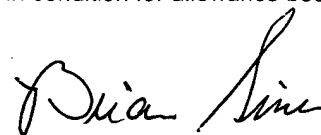
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): None (see final office action, mailed 11/24/2006).
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_



Brian J. Sines  
Primary Examiner  
Art Unit: 1743

## **ADVISORY ACTION**

### ***Response to Arguments***

Regarding the rejection of claims 66 – 94 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 4 of Liljestrand in view of Ghaed, applicant's arguments filed 2/26/2007 have been fully considered but they are not persuasive. The applicant argues that the double patenting rejection is improper. However, briefly as discussed here, the double patenting rejection regarding claim 66 over Liljestrand in view of Ghaed is indeed proper.

With respect to claim 66 of the instant application and claim 1 of Liljestrand, Liljestrand recites an apparatus for conducting electrochemiluminescence (ECL) measurements, wherein the apparatus is comprising:

a cell having at least one cell wall which includes a transparent portion adjacent to an ECL chamber defined within said cell;

a working electrode abutting said ECL chamber and in optical registration with said transparent portion;

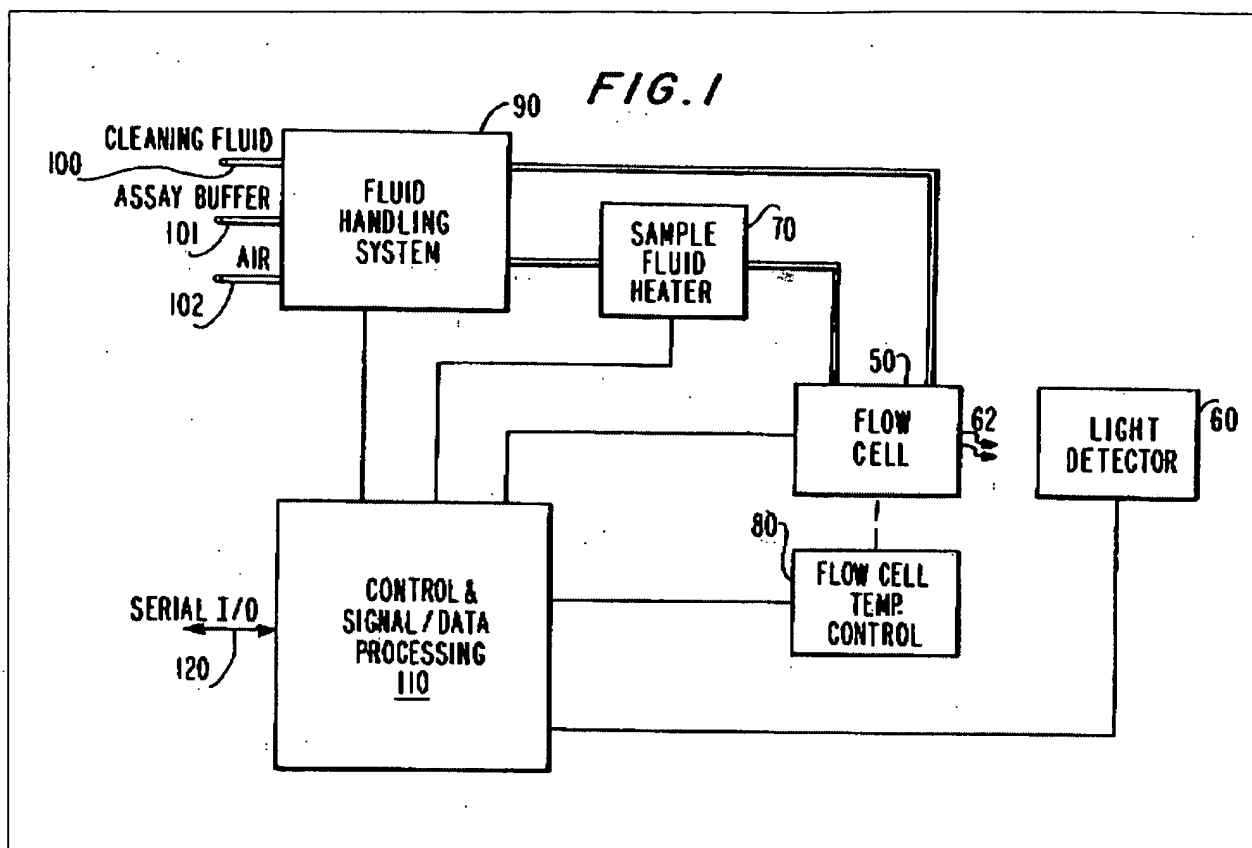
a counter electrode abutting said ECL chamber; and

an electrically-shielded window adjacent to and in optical registration with said transparent portion.

Liljestrand does not specifically teach a heater that is thermally coupled or in thermal contact with the working electrode for adjusting the operating temperature of the working electrode. Liljestrand does not specifically teach a heater that is thermally coupled or in thermal

contact with at least one surface of the chamber for adjusting the operating temperature of the chamber, and thereby the operating temperature of the working electrode.

Ghaed does teach that the electrochemiluminescence process is substantially sensitive to the temperature of the sample under test (see col. 6, lines 38 – 49). Ghaed does teach the use of a fluid handling system that has a fluid heater system in conjunction with the flow cell (see col. 6, lines 49 – 61). The fluid heater 70, although not in direct contact with the flow cell 62, is considered *thermally coupled* with the flow cell 62, where the electrochemiluminescence process occurs, and fluid handling system 90 (see, e.g., col. 6, line 15 – col. 7, line 31; figure 1). The recitation in the claim that the heater is *thermally coupled* with the working electrode is given a reasonable broad interpretation meaning that the heater need not be in direct contact with the working electrode, but only needs to be capable of inducing a temperature change in the environment proximal to the working electrode. If the prior art structure is capable of performing the intended use, then it meets the claim. This recitation simply does not exclude what is taught by Ghaed pertaining to the fluid heater and flow cell arrangement.



Liljestrand does teach that the electrochemiluminescence process occurs at the working electrode 140 site when testing assay samples (see, e.g., 14, lines 41 – 64). It is obvious that the electrochemiluminescence process occurs at the working electrode 140 site of the Liljestrand device. This feature of the device would have been reasonably recognized by a person of ordinary skill in the art independent of the Liljestrand disclosure. Hence, a person of ordinary skill in the art would have recognized the suitability of using a heating device to control the temperature of the working electrode test site in the disclosed device (see MPEP § 2144.07). Furthermore, a person of ordinary skill in the art would accordingly have had a reasonable expectation for success in incorporating the use of a heating element for effectively inducing and controlling the electrochemiluminescence test process occurring at a working electrode test site

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in the disclosed apparatus (see MPEP § 2143.02). Therefore, it still would have been obvious to a person of ordinary skill in the art to incorporate the use of a heater associated with either the working electrode or surface of the chamber proximal to the working electrode as claimed to facilitate effecting heating and temperature control for the disclosed device.

As shown above in the double-patenting rejection, the claims of the instant application and the cited patent are compared and differences noted. Furthermore, the specification of the prior patent can indeed be relied upon in a nonstatutory obviousness-type double patenting rejection. The MPEP clearly indicates that in an obviousness-type double patenting rejection, the specification of the patent may be used as prior art in determining if the present application claims an *obvious variation* of an invention claimed in the cited prior patent. “[T]hose portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent[.]” In addition, “this use of the disclosure is not contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined.” (see MPEP § 804, page 800 – 22; Rev. 5, Aug. 2006). The disclosure of Liljestrand of the electrochemiluminescence process occurring at the working electrode site 140 of the device is merely recognizing what process is obviously already occurring at the working electrode site. Therefore, the claimed apparatus of the instant application is clearly an obvious variation of the claimed apparatus of the cited patent. Therefore, this rejection is indeed considered proper and maintained.

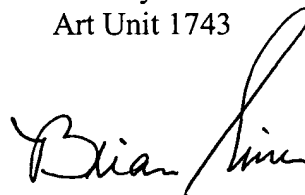
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian J. Sines  
Primary Examiner  
Art Unit 1743

A handwritten signature in black ink, appearing to read "Brian Sines", is written over the printed name and title.